

REMARKS

Claims 1-58 remain pending in the application.

Claims 1, 4-21 and 24-58 over Matsumoto in view of Kanevsky

Claims 1, 4-21 and 24-58 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,678,720 to Matsumoto ("Matsumoto") in view of U.S. Patent Application Publication No. 2002/0069069 to Kanevsky et al. ("Kanevsky"). The Applicant respectfully traverses the rejection.

Claims 1, 4-20 and 53-58 recite a system and method initiating a transfer of an instant message and a chat history in a first data format compatible with a first **real-time chat** system, and transferring the instant message and the chat history in a second data format compatible with a second **real-time chat** system. Claims 21 and 24-52 recite a system and method to convert an instant message and a chat history from a first data format that is compatible with a first **real-time chat** system to a second data format that is compatible with a second **real-time chat** system.

The Examiner acknowledged that Matsumoto does not disclose a second system that is a real time instant messaging system (See Office Action, page 2). The Examiner relies on Kanevsky to allegedly make up for the deficiencies in Matsumoto to arrive at the claimed features. The Applicant respectfully disagrees.

The reason that Matsumoto fails to disclose a second system that is a real time instant messaging system is that Matsumoto's second system has nothing to do with instant messaging, as the Examiner acknowledged. Matsumoto discloses a conversion means that converts a message history, which is text data, to voice data, plays back the voice and sends it to a telephone set and alternately converts the message history to image data to be sent to a fax machine (See Matsumoto, col. 4, lines 60-62; col. 4, lines 62-64). Thus, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting

ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). NOTHING within Matsumoto nor Kanevsky suggests the Examiner's modification of Matsumoto's telephone set or fax machine to instead be a real-time chat system, as recited by claims 1, 4-21 and 24-58.

Moreover, the Examiner's motivation for modifying Matsumoto with the disclosure of Kanevsky "to connect disparate chat service systems (Kanevsky, col. 1, lines 11; last line)" is nonsensical (See Office Action, page 3). The Examiner's motivation is why Kanevsky came up with his invention NOT a reason to modify Matsumoto. Modifying Matsumoto, that fails to disclose a second chat service, i.e., instead disclosing a fax machine and a telephone, would NOT benefit from connection of disparate chat service systems, i.e., a first chat service and a second chat service.

The Examiner relies on Kanevsky to allegedly make up for the deficiencies in Matsumoto to arrive at the claimed features. The Applicant respectfully disagrees.

Kanevsky appears to disclose a system and method for real time teleconferencing, where one of the participants is deaf or hearing-impaired (See Abstract). In Integration Server receives all of the participant's chat messages, which have various formats, and translates them into a format used by the chat service system of the deaf or hearing-impaired participant (See Kanevsky, Abstract).

Thus, Kanevsky appears to disclose conversion of a message from a first chat system to a second chat system. However, Kanevsky fails to disclose or suggest conversion of an instant message AND a chat history. Thus, neither Matsumoto nor Kanevsky disclose or suggest conversion of an instant message AND a chat history between TWO real-time systems, as recited by claims 1, 4-21 and 24-58.

Matsumoto theoretically modified by the disclosure of Kanevsky would at best suggest conversion of a message history to voice for a telephone set or an image for a fax machine (Matsumoto) and conversion of a chat message to a chat service system for a deaf or hearing-impaired participant

(Kanevsky). Matsumoto modified by the disclosure of Kanevsky fails to disclose or suggest an instant message AND a chat history between TWO real-time systems, as recited by claims 1, 4-21 and 24-58.

A benefit of converting an instant message and a chat history from a first data format that is compatible with a first real-time messaging system to a second data format that is compatible with a second real-time chat system and transferring an instant message and a chat history in a second data format compatible with a second real-time chat system is, e.g., the ability to chat with and send messages between incompatible real-time systems more completely. Conventionally, there are numerous incompatible real-time chat systems that allow users to send messages amongst their individual subscribers. However, a user of one real-time chat system cannot send a message to a user of another real-time chat system. A system and method of converting an instant message and chat history facilitates user of incompatible system to communicate more completely. The cited prior art fails to disclose or suggest the claimed features having such benefits.

Accordingly, for at least all the above reasons, claims 1, 4-21 and 24-58 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 2, 3, 22 and 23 over Matsumoto in view of Kanevsky and Scott

Claims 2, 3, 22 and 23 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Matsumoto in view of Kanevsky, and further in view of U.S. Application Publication No. 2001/0044820 to Scott ("Scott"). The Applicant respectfully traverses the rejection.

Claims 2, 3, 22 and 23 are dependent on claims 1 and 21 respectively, and are allowable for at least the same reasons as claims 1 and 21.

Claims 2 and 3 recite a method of initiating a transfer of an instant message and a chat history in a first data format compatible with a first real-time chat system, and transferring the instant message and the chat history in a second data format compatible with a second real-time chat system. Claims 22

and 23 recite a system to convert an instant message and a chat history from a first data format that is compatible with a first real-time chat system to a second data format that is compatible with a second real-time chat system.

As discussed above, Matsumoto in view of Kanevsky fails to disclose or suggest conversion of an instant message AND a chat history between TWO real-time systems, as recited by claims 2, 3, 22 and 23.

Scott was relied on to disclose indicating an unavailability in response to a non-establishment of a communication channel (See Office Action, page 15). Scott's invention is directed toward monitoring and detecting static, dynamic and active web content (Abstract). However, Scott fails to disclose or suggest disclose or suggest conversion of an instant message AND a chat history between TWO real-time systems, as recited by claims 2, 3, 22 and 23.

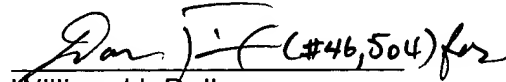
Thus, even if it were obvious to modify Matsumoto with the disclosure of Kanevsky and Scott (which it is not since the three inventions are addressing completely different problems within their respective arts), the theoretically modified Matsumoto would fail to disclose or disclose or suggest conversion of an instant message AND a chat history between two real-time chat systems, as recited by claims 2, 3, 22 and 23.

Accordingly, for at least all the above reasons, claims 2, 3, 22 and 23 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



William H. Bollman

Reg. No.: 36,457

Tel. (202) 261-1020

Fax. (202) 887-0336

MANELLI DENISON & SELTER PLLC

2000 M Street, NW 7TH Floor

Washington, DC 20036-3307

TEL. (202) 261-1020

FAX. (202) 887-0336

WHB/df